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OMAHA, NE 68124

EXAMINER

HAND, MELANIE JO

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TROY M. JUST

Appeal 2008-2428
Application 10/668,785
Technology Center 3700

Decided: August 13, 2008

Before ERIC GRIMES, RICHARD M. LEBOVITZ, and MELANIE L.
MCCOLLUM, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a pre-fill vaginal applicator. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

BACKGROUND

“The use of vaginal applicators for application of medication is well known in the art. Although the prior art vaginal applicators have met with success, the same suffer from certain drawbacks or disadvantages. ... [T]he prior art vaginal applicators are designed in such a way that they may possibly be re-used which may lead to the spread of disease” (Specification 1). The Specification discloses a “pre-fill vaginal applicator which is designed ... to prevent its re-use” (*id.* at 3).

DISCUSSION

1. CLAIMS

Claims 1-3, 8, 10 and 11 are pending and on appeal. Claim 1 is representative and reads as follows:

Claim 1: A pre-fill vaginal applicator, comprising:
a tubular barrel having a dispensing end provided with at least one opening formed therein and an open end;
said barrel having an inner surface;
a selectively removable closure closing said dispensing end of said barrel;
a resilient piston having first and second ends, selectively slidably positioned in said barrel; said piston having an outer surface which is in sealing contact with said inner surface of said barrel to define a medication reservoir between said first end of said piston and said dispensing end of said barrel;
said second end of said piston having an opening extending thereinto which terminates between said first and second ends of said piston;
an elongated plunger having first and second ends adapted to be inserted into said open end of said barrel whereby said first end thereof may be inserted into said opening in said second end of said piston to detachably connect said plunger to said piston;
said piston, prior to insertion into said barrel, having a larger outside diameter than the inside diameter of said barrel whereby said piston is in a

compressed state against said inner surface of said barrel when said piston is inserted into said barrel;

said plunger, when connected to said piston and being moved towards said dispensing end of said barrel, causing said resilient piston to longitudinally stretch to permit said piston to slide towards said dispensing end thereby forcing medication in said medication reservoir to be ejected from said opening in said dispensing end of said barrel;

said first end of said plunger being detachably connected to said piston whereby movement of said plunger away from said piston will cause said first end of said plunger to disconnect from said piston so that said piston remains in said barrel thereby ensuring that the applicator may not be reused.

2. OBVIOUSNESS

Claims 1-3, 8, 10, and 11 stand rejected under 35 U.S.C. § 103 as obvious in view of Ferrer.¹

The Examiner finds that Ferrer discloses a “vaginal medication applicator 10” meeting all the limitations of the rejected claims except that “Ferrer ... does not explicitly teach that the plunger as it exists within an assembled applicator, is detachably connected to the piston in such a manner as to be capable of being disconnected from said piston, thereby leaving the piston in the main body portion” (Answer 3-4).

The Examiner concludes that “it would be obvious to one of ordinary skill in the art to modify the applicator of Ferrer to be manufactured separately from the piston in such a way as to allow the plunger to disconnect from the piston upon completion of use, as these pieces are manufactured separately and are capable of being assembled separately as an alternative means of assembling that produces a substantially identical

¹ Ferrer et al., US 6,364,854 B1, April 2, 2002.

product to the claimed invention” (*id.* at 4). The Examiner reasons that “[t]here is absolutely nothing taught by Ferrer that holds the rod 31 in the opening 45 such that it cannot be detachably connected at a later time, e.g. after dispensation of medication” (*id.* at 5).

Appellant argues that, “even if the piston and plunger were made as separate components,” Ferrer does not suggest “that the piston would remain in the barrel of the applicator upon the plunger being removed from the applicator” (Appeal Br. 7). Appellant further argues that “[t]he unique relationship of the barrel, piston and plunger [of the claimed invention] ensures that the plunger will disconnect from the piston if the plunger is moved outwardly from the barrel upon the medication being dispensed from the applicator” and that Ferrer does not suggest “that the plunger will separate from the piston as claimed” (*id.* at 7-8).

We agree with Appellant that Ferrer does not support a *prima facie* case of obviousness. In particular, we agree that the Examiner has not adequately explained how the references would have suggested an applicator in which the first end of the plunger is “detachably connected” to the piston such that movement of the plunger away from the piston will cause the first end of the plunger “to disconnect from” the piston as is necessary to meet the limitations of claim 1.

Ferrer discloses an applicator that has a tubular body, a plunger, and a piston (Ferrer, abstract). Figure 9 of Ferrer is shown for illustration:

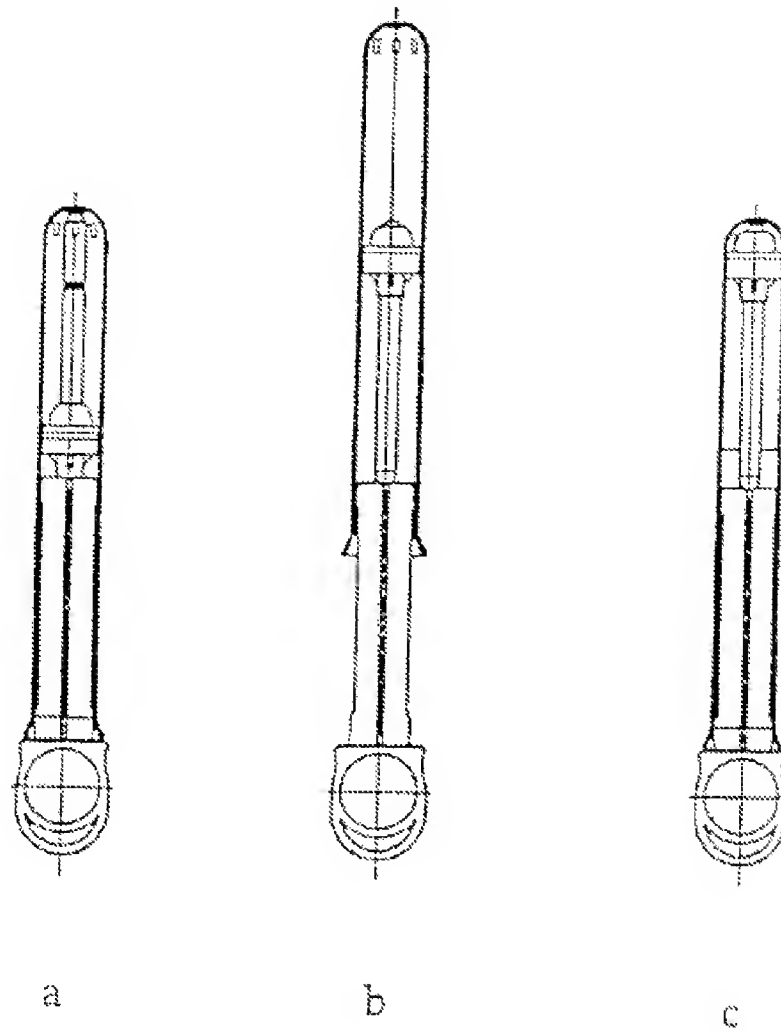


Fig. 9 is said to show the applicator “in different positions during use; (a) applicator in the initial compact position, as received by the user; (b) applicator showing the plunger and piston in an assembled position, ready to discharge the medication; (c) applicator after use, showing the assembled impeller means fully depressed” (*id.* at col. 2, ll. 43-48).

That is, Ferrer discloses an applicator device having a tubular body with a dispensing end, a piston within the tubular body, and a plunger; the plunger being initially disposed with a portion of it extended through the center of the piston toward the dispensing end (see Fig. 9a). Upon retraction

of the plunger from the tubular body (i.e., through the center of the piston), the end of the plunger becomes engaged with the piston (see Fig. 9b) and allows the piston and the plunger to be moved toward the dispensing end with pressure on the plunger (see Fig. 9c).

Ferrer also discloses that when the plunger is pulled out, “the rod 31 of the plunger pass[es] through the orifice 45 of the piston until the piston engages with the plunger. At this point, the groove 35 and the annular rib 34 of the plunger will have fit into locking engagement with the annular projection 46 and recess 47 of the piston, respectively, thus fixing the piston at one end of the plunger, as shown in FIG. 9b” (*id.* at col. 6, ll. 24-34; reference numerals not shown in Fig. 9; see Figs. 3-5 for reference numerals).

Given the explicit disclosure in Ferrer that the piston and the plunger fit into “locking engagement” upon retraction of the plunger and that the piston is fixed at one end of the plunger, we do not agree with the Examiner’s conclusion that, because the plunger and piston are manufactured separately, it would be obvious to one of ordinary skill in the art to modify the applicator of Ferrer to be manufactured in such a way as to allow the plunger to disconnect from the piston upon completion of use. Thus, we agree with Appellant that the Examiner has not adequately shown that the cited references would have suggested the claim limitation of “said first end of said plunger being detachably connected to said piston whereby movement of said plunger away from said piston will cause said first end of said plunger to disconnect from said piston.”

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Application 10/668,785

We therefore agree with Appellant that the Examiner has not made out a prima facie case of obviousness based on the cited reference. The rejection of claims 1-3, 8, 10, and 11 under 35 U.S.C. § 103 is reversed.

REVERSED

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